

**REMARKS**

Claims 41-59 are currently pending. In the Office Action mailed June 21, 2010 (hereinafter, "Office Action"), the Examiner rejected claims 41, 44, 45, 50, 53, and 54 under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 6,409,514 to Bull (hereinafter, "Bull"); rejected claims 42 and 51 under 35 U.S.C. § 103(a) as being unpatentable over Bull in view of International Patent Application No. WO 98/03953 to Simmons (hereinafter, "Simmons"); rejected claims 43, 46-48, 52, 55-57, and 59<sup>1</sup> under 35 U.S.C. § 103(a) as being unpatentable over Bull in view of the Examiner's Official Notice; and rejected claims 49 and 58 under 35 U.S.C. § 103(a) as being unpatentable over Bull in view of the Examiner's Official Notice and an article entitled "Professional Development in Technology: Catalyst for School Reform" by Patricia E. Holland (hereinafter, "Holland").

**I. Rejection under 35 U.S.C. § 102(e)**

Applicant respectfully traverses the rejection of claims 41, 44, 45, 50, 53, and 54 under 35 U.S.C. § 102(e) as being anticipated by Bull. A proper anticipation rejection requires that "each and every element set forth in the claim be found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131. In addition, "[t]he elements must be arranged as required by the claim . . . ." Id. (emphasis added).

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<sup>1</sup> Applicant notes that, in the statement of rejection on page 6 of the Office Action, the Examiner does not indicate that claim 59 is rejected under § 103(a) as being unpatentable over Bull in view of the Examiner's Official Notice. However, in the body of the rejection, the Examiner states that "[claim 59] is rejected using the same art and rationale used above for rejecting claim 47." Office Action, p. 10. Without conceding the accuracy of this statement or any of the implications that may emanate therefrom, Applicant nevertheless responds herein to the rejection of claim 59 over Bull in view of the Examiner's Official Notice.

Here, Bull fails to disclose the recitations of independent claims 41 and 50, including, *inter alia*, “receiving . . . data regarding subject matter of a course that is to be developed” and “developing . . . the course based on the delivery criteria and the forecasted future demand,” as recited in independent claim 41, and similarly recited in independent claim 50.

The Examiner cites to column 3, lines 24-61 of Bull, alleging that Bull discloses the claim 1 recitation of “receiving, via a computer system, data regarding subject matter of a course that is to be developed,” and cites to the same passage of Bull, alleging that Bull discloses the claim 1 recitation of “developing, via the computer system, the course based on the delivery criteria and the forecasted future demand.” Office Action, pp. 3-4.

However, the cited section of Bull does not provide any teaching of a “course that is to be developed,” as required by independent claim 41. Consequently, Bull cannot further teach “receiving . . . data regarding subject matter of a course ***that is to be developed***” (emphasis added) and “***developing . . . the course*** based on the delivery criteria and the forecasted future demand” (emphasis added), as recited in independent claim 41, and similarly recited in independent claim 50.

Instead, Bull teaches “a method [that includes] scheduling [a] worker for a selected class in response to user input” and “tracking an available class the worker might attend.” Bull, Abstract. In Bull, a “‘selected class’ is a class that the worker must or should take under a given set of criteria” and an “‘available class’ is one that will be given based on individual worker’s training needs.” Id. at 3:29-32. In other words, Bull’s methods are directed toward ***pre-existing courses***. Id. at 3:25-26.

Simply put, Bull's pre-existing courses do not meet the recitations in independent claim 41 of "receiving . . . data regarding subject matter of a course ***that is to be developed***" (emphasis added) and "***developing . . . the course*** based on the delivery criteria and the forecasted future demand" (emphasis added).

Thus, Bull fails to disclose all of the recitations of Applicant's independent claim 41. Therefore, the rejection of independent claim 41 under 35 U.S.C. § 102(e) should be withdrawn, and the claim allowed.

Independent claim 50, although of different scope, includes recitations similar to those discussed above with respect to independent claim 41. Therefore, for at least the same reason as set forth above in connection with independent claim 41, the rejection of independent claim 50 should be withdrawn, and the claim allowed.

Claims 44 and 45 depend from independent claim 41. Claims 53 and 54 depend from independent claim 50. For at least the same reasons as set forth above in connection with their corresponding independent claims, the rejection of dependent claims 44, 45, 53, and 54 under 35 U.S.C. § 102(e) should be withdrawn, and the claims allowed.

## **II. Rejections under 35 U.S.C. § 103(a)**

Applicant respectfully traverses the rejection of claims 42 and 51 under 35 U.S.C. § 103(a) as being unpatentable over Bull in view of Simmons (Office Action, p. 5), the rejection of claims 43, 46-48, 52, 55-57, and 59 under § 103(a) as being unpatentable over Bull in view of the Examiner's Official Notice (id. at p. 6), and the rejection of claims 49 and 58 under § 103(a) as being unpatentable over Bull in view of the Examiner's Official Notice and Holland (id. at p. 10).

In this application, the pending claims are not obvious because, among other things, the cited references do not teach or suggest each and every feature of Applicant's independent claim 41 and 50, from which claims 42-49 and 51-57 depend. Nor do the cited references teach or suggest each and every feature of Applicant's independent claim 59.

The key to supporting any rejection under 35 U.S.C. § 103(a) is the clear articulation of the reasons why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See M.P.E.P. § 2141, 8<sup>th</sup> Ed., Rev. 6 (Sept. 2007).

By virtue of their dependence from independent claim 41, claims 42-49 require a combination including, *inter alia*, "receiving . . . data regarding subject matter of a course that is to be developed" and "developing . . . the course based on the delivery criteria and the forecasted future demand," as recited in independent claim 41. Simmons, the Examiner's Official Notice, and Holland, whether taken alone or in any reasonable combination, fail to overcome the deficiencies of Bull because none of Simmons, the Examiner's Official Notice, and Holland disclose or suggest at least these recitations.

The Examiner cites Simmons as "teach[ing] wherein providing the developed course further includes at least one of: providing, via the computer system, the developed course to the members via virtual instructor led training (p. 1, lines 13-17); and providing, via the computer system, the developed course to the members via self-paced training (p. 2, lines 6-11)." Office Action, pp. 5-6. The Examiner takes Official Notice "that preparing, via the computer system, course materials, including at least one

of ordering the course materials, initiating reproduction of the course materials, or initiating delivering of the course materials is old and well-known.” Id. at p. 7 (emphasis in original). Finally, the Examiner cites Holland as “teach[ing] wherein training the instructor includes: certifying, via the computer system, of presentation skills related to the instructor (p. 5, par. 5); and certifying, via the computer system, of effective use of delivery mechanisms by the instructor (p. 5, par. 5).” Id. at p. 11.

While Applicant does not concede the Examiner’s statements regarding Simmons, the Examiner’s Official Notice, and Holland, such teachings do not correspond to Applicant’s claim recitations including, *inter alia*, “receiving . . . data regarding subject matter of a course that is to be developed” and “developing . . . the course based on the delivery criteria and the forecasted future demand,” as recited in independent claim 41, and similarly recited in independent claim 50. Accordingly, neither Bull, nor Simmons, nor the Examiner’s Official Notice, nor Holland, nor their combination, discloses or suggests at least the above-quoted elements of independent claim 41, from which claims 42-49 depend. Therefore, independent claim 41 is nonobvious over Bull, Simmons, the Examiner’s Official Notice, and Holland under 35 U.S.C. § 103(a), and should be allowed.

Claims 42-49 are also nonobvious over Bull, Simmons, the Examiner’s Official Notice, and Holland at least because of their dependence from nonobvious independent claim 41. Therefore, the rejection of claims 42-49 under § 103(a) should be withdrawn, and the claims allowed.

Independent claims 50 and 59, although of different scope, include recitations similar to those of independent claim 41. For at least the same reason as set forth

above in connection with independent claim 41, neither Bull, nor Simmons, nor the Examiner's Official Notice, nor Holland, nor their combination, discloses or suggests at least the above-quoted elements of independent claim 50, from which claims 51-58 depend, and independent claim 59. Therefore, independent claims 50 and 59 are nonobvious over Bull, Simmons, the Examiner's Official Notice, and Holland under 35 U.S.C. § 103(a), and should be allowed.

Claims 51-58 are also nonobvious over Bull, Simmons, the Examiner's Official Notice, and Holland at least because of their dependence from nonobvious independent claim 50. Therefore, the rejection of claims 51-58 under § 103(a) should be withdrawn, and the claims allowed.

### **III. Conclusion**

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

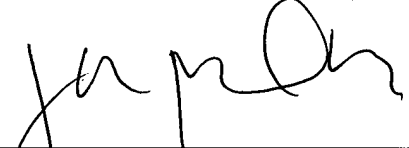
Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
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Dated: August 31, 2010

By: \_\_\_\_\_

  
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